

REMARKS

This Request for Reconsideration is filed in response to the Office Action of August 1, 2007 in which claims 1-3, 6-10, and 13-16 were rejected and claims 4, 5, 11 and 12 objected to. New claims 17-22 including new independent claim 18 have been added.

Claims 1-2, 8-9, and 15-16 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *King* (U.S. 2004/0239559).

The *King et al* reference was filed on June 2, 2003, i.e., only eight days before the international filing date of the present application, i.e., June 10, 2003.

The applicants submit herewith two Rule 131 declarations which together constitute a showing of facts that, in character and weight, establish a conception of the invention prior to the effective date of June 2, 2003 of the *King et al* reference coupled with due diligence from at least immediately prior to said date of June 2, 2003 to the subsequent filing of the application in the International Bureau under International Application No. PCT/IB03/02174 on June 10, 2003.

The showing of facts establishing prior invention constitute a showing of facts in a WTO member country, i.e., Finland after January 1, 1996 (one year after entry into force of the WTO agreement) pursuant to Public Law 103-465. Under the GATT Treaty, patents shall be available without discrimination as to place of invention under 35 U.S.C. § 104.

Under MPEP § 715.07, the essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the facts.

I. Conception

The attached declaration under 37 CFR 1.131 of Seppo Rousu constitutes a recitation of facts that occurred prior to June 2, 2003 and that establish a fully formed conception of the invention. The attachment 1 to his declaration constitutes an Invention Report dated prior to June 2, 2003 showing the basic idea of the invention as being to increase attenuation between GPS and GSM antennas with attenuation increased by detuning the GPS antenna out of the GPS frequency when

the GSM transmitter is transmitting and leaving the GPS antenna in normal center frequency operational mode when the GSM is not transmitting.

Receipt of this Invention Report is corroborated by the declaration of facts by Tina Ojala in numbered paragraphs 2-6 of her declaration.

The power point slide set attached as Attachment 2 to the declaration of Seppo Rousu further establishes the existence of a fully formed conception prior to the effective date of the *King et al* reference as described in the declaration of Seppo Rousu in paragraphs 3-12 of his declaration where a complete description of the correspondence between the features of the invention and the figures of the slideset and specification is provided.

These facts establish the necessary proof of conception with sufficient clarity to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill. In other words, the Invention Report (Attachment 1 to Seppo Rousu's declaration) either alone or in conjunction with the power point slide set (Attachment 2 to Seppo Rousu's declaration) demonstrate the complete performance of the mental part of the inventive act because it shows the formation of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice. Thus, it has been shown by these factual proofs that every feature of the invention was in existence and known at the time of the conception. Moreover, this conception has been proved by the corroborating evidence of Tina Ojala in her declaration where she indicates receipt of both the invention report and the power point slide set (see the statement number 8 of Tina Ojala where she indicates that she received the power point slide set before June 2, 2003 and attaches same as Attachment 3 to her declaration).

## II. Constructive Reduction to Practice

Regarding the constructive reduction to practice on June 10, 2003, the subject U.S. patent application Serial No. 10/559,918 is the U.S. national stage of PCT/IB03/02174 and 35 U.S.C. § 104 makes it clear that facts showing a completion of the invention by a 35 U.S.C. § 365 filing is permitted.

Applicant submits that the requirements of 35 U.S.C. § 112, first paragraph,

have been met and therefore the international application and this U.S. national stage thereof meets the requirements of 35 U.S.C. § 120 and 112, first paragraph. The technical description in the specification clearly establish a practical utility and sufficient disclosure under the “how to use” and “how to make” requirements thereof. See the declaration of Seppo Rousu for the particular ways in which the claimed invention corresponds to the drawings of the present application. The written description is sufficient so that when the entire specification is considered, the only necessary and reasonable construction that would be given by a person skilled in the art is that each positive limitation of the claims is shown in and supported by the specification and drawings by an enabling disclosure.

### III. Diligence

Regarding the diligence requirement, the critical period begins not at the time of conception but rather just prior to June 2, 2003, i.e., the critical date of the 102(e) filing of *King et al.* See MPEP 2138.06 and 715.07(a).

The declaration of Tina Ojala shows that the German law firm of Cohausz & Florack was engaged in the drafting process at least in the period from May 15, 2003 up to at least June 3, 2003 followed by a filing date on June 10, 2003 so as to be coordinated with the filing of three other GPS applications, three of which were handled by Cohausz & Florack and one of which was handled by another firm.

After receiving a first draft on May 15, 2003 (Attachment 5 of the declaration of Tina Ojala) and commenting thereupon on May 23, 2003 by return email (Attachment 6), a second draft was sent by Cohausz & Florack to the assignee on May 23, 2007 (Attachment 7 of the declaration of Tina Ojala).

Tina Ojala sent an email to Cohausz & Florack on May 28, 2003 (Attachment 8 of her declaration) concerning a discussion pertaining to the GPS and Galileo Systems and asking Cohausz & Florack to add discussion of same to several applications in preparation at the same time concerning GPS and which were to be filed on the same day in week 24 of 2003.

On June 2, 2003, Tina Ojala states that a reply to the draft of May 15, 2003 was sent back to Cohausz & Florack as evidenced by the attachment 9 of her declaration.

A third draft was sent in response to the comments to the second draft by Cohausz & Florack on June 2, 2003 to which the assignee replied by email (Attachment 10 of the declaration of Tina Ojala) with comments on June 3, 2003 asking that the case be filed in the International Bureau in week 24 on June 10, 2003 so as to be coordinated with the filing of the three other GPS applications.

It is again noted that the firm of Cohausz & Florack was preparing three GPS applications to be filed on that same day (June 10, 2003) and another firm was handling the other application and that there was a public holiday in Germany on Monday, June 9, 2003 and that there was a long holiday weekend of June 7-9, 2003 (see Attachment 10 of the declaration of Tina Ojala).

#### IV. Conclusion

Therefore, the applicant has established a date of conception before May 15, 2003, i.e., before the critical date of June 2, 2003 coupled with diligence beginning at least on May 15, 2003 and continuing until the constructive reduction to practice date of June 10, 2003.

Withdrawal of the novelty rejection of claims 1-2, 8-9 and 15-16 is requested.

Regarding the obviousness rejection of claims 3 and 10, the *King et al* reference has been removed as an effective 102(e)/103(a) reference and therefore withdrawal of this obviousness rejection of claims 3 and 10 is also requested.

Regarding the obviousness rejection of claims 6-7 and 13-16, the above considerations concerning *King et al* apply here as well and these dependent claims of claims 1 and 8 are at least patentable for the same reasons as given above, i.e., that *King et al* is not an effective 35 U.S.C. § 102(e) reference by virtue of the above proof of prior invention.

Withdrawal of the obviousness rejection of claims 6-7 and 13-14 is requested.

The presentation of facts proving a date of prior invention is not an admission that the *King et al* reference contains disclosure that would render the present invention unpatentable under Sections 102 or 103 of Title 35.

The indication of allowable subject matter in claims 4-5 and 11-12 is noted

with appreciation, but it is believed that the Examiner will be persuaded by the above proof of prior invention that all of the claims are patentable over the prior art.

Applicant submits herewith a petition for a three-month extension of time along with the fee therefor. If the petition is missing, the Commissioner is authorized to consider this paper to be a petition for the appropriate extension of time and is further authorized in case the fee is missing or incorrect to deduct the correct fee from our Deposit Account No. 23-0442. If the fee is excessive or not required, the Commissioner is authorized to credit our Deposit Account No. 23-0442 as well.

Applicant also submits herewith an additional claim fee of \$300.00 for added claims 17-22. If the fee is missing or inadequate the Commissioner is authorized to deduct the fee or any shortfall from our Deposit Account No. 23-0442.

The objections and rejections of the Office Action of August 1, 2007, having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of claims 1-22 to issue is earnestly solicited.

Respectfully submitted,



Francis J. Maguire  
Attorney for the Applicant  
Registration No. 31,391

FJM/mo  
WARE, FRESSOLA, VAN DER SLUYS  
& ADOLPHSON LLP  
755 Main Street, P.O. Box 224  
Monroe, Connecticut 06468  
(203) 261-1234